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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,947	12/26/2001	Hsuan-Yin Lan-Hargest	12938-003002	8464
26171	7590	11/22/2004	EXAMINER ZUCKER, PAUL A	
FISH & RICHARDSON P.C. 1425 K STREET, N.W. 11TH FLOOR WASHINGTON, DC 20005-3500			ART UNIT 1621	PAPER NUMBER

DATE MAILED: 11/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/025,947	<b>Applicant(s)</b> LAN-HARGEST ET AL.	
	<b>Examiner</b> Paul A. Zucker	<b>Art Unit</b> 1621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 September 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5,7,8,12,13,16,17,22,25,26 and 80-102 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,7,8,12,13,16,17,22,25,26,80-97 and 99-102 is/are rejected.
- 7) ☐ Claim(s) 98 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Current Status***

1. This action is responsive to Applicants' amendment of 20 September 2004.
2. Receipt and entry of Applicants' amendment is acknowledged.
3. Claims 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26, and 80-102 are pending.
4. The rejection under 35 USC § 112, second paragraph, set forth in paragraph 1 of the previous Office Action mailed 19 March 2004 is withdrawn in response to Applicants' amendment.
5. The rejections under 35 USC § 103 set forth in paragraphs 2 and 3 of the previous Office Action in Paper No 8 mailed 19 March 2004 is withdrawn in response to Applicants' amendment.

### ***New Rejections***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 112***

6. Claims 7, 8, 16, 17, 25, 26, 85, 86, 89, 96, 97, 100 and 101 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 7, 16, 25, 85, 89 and 100 recite the limitation "C<sub>1-2</sub> alkyl". There is insufficient antecedent basis for this limitation in the claims. Claims 7, 16, 25, 85, 89 and 100 and their dependents are therefore rendered indefinite.

***Claim Rejections - 35 USC § 102***

7. Claims 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26, 80-90 and 102 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoorspool et al (Monatshefte fuer Chemie, Preparation of Phenoxy Radicals, 1967, 98(4) pages 1256-1261). Hoorspool discloses (Page 1259, lines 26-41) the synthesis of the compound 5-phenoxy-2,4-pentadienoic acid. This compound corresponds to compound of formula (I) in which A is unsubstituted phenyl and  $Y^1 = O$ , L substituted with phenyl. Hoorspool further discloses (ibid) that this compound is precipitated from aqueous HCl solution and recrystallized from alcohol solution. The Examiner considers both solutions to be pharmaceutical compositions with the solvents corresponding to pharmaceutically acceptable carriers.
8. Claims 1-5, 7, 8, 12, 13, 16, 17, 22, 26, 91-97, 99, 100 and 102 are rejected under 35 U.S.C. 102(b) as being anticipated by Kvita et al (Helvetica Chimica Acta, 12983, 66(8), pages 2769- 2777). Kvita discloses (Page 2770, Table I, entries numbered 6-16) the compounds **2** which correspond to compounds of instant formula (I). These compounds are present as a mixture of amino-substituted double bond isomers and thus the trans isomer is also present.

***Claim Objections***

9. Claims 98 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Allowable Subject Matter***

10. Claims 98 is drawn to allowable subject matter. The following is a statement of reasons for the indication of allowable subject matter: The closest prior art of record Hoorspool et al (Monatshefte fuer Chemie, Preparation of Phenoxy Radicals, 1967, 98(4) pages 1256-1261) and Kvita et al (Helvetica Chimica Acta, 12983, 66(8), pages 2769- 2777) neither alone nor in combination either disclose or render obvious the subgenus of compounds claimed in claims 98 and 101.

***Conclusion***

11. Claims 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26, and 80-102 are pending. Claims 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26, and 80-97, 99, and 100-102 are rejected. Claims 98 is objected to.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing


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date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Zucker whose telephone number is 571-272-0650. The examiner can normally be reached on Monday-Friday 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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Technology Center 1600